REMARKS

In response to the above-identified Office Action, Applicant does not amend, cancel or add any new claims. Accordingly, claims 1-39 are pending.

I.   Claims Rejected Under 35 U.S.C. § 103

Claims 1-24, 29 and 31-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,426,778 issued to Valdez, Jr. (hereinafter "Valdez") in view of U.S. Patent No. 5,706,457 issued to Dwyer, et al. (hereinafter "Dwyer").

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach or suggest each of the elements of the claim. In regard to claim 1, the Examiner argues that Valdez teaches "transferring said edited time based stream to a sequential storage device using an icon" and cites col. 6, lines 5-40 and col. 7, lines 9-67 to support this assertion. Applicant has reviewed the cited sections of Valdez and has been unable to discern any part therein that teaches or suggests these elements of claims 1, 10, 24 and 31. Rather, the cited sections in col. 6, lines 5-40 provides a general description of an editing system which manipulates media files that may include interactive elements where these elements may be viewed using a viewer system. Applicant has not discerned any part of this cited section of Valdez that teaches the use of an icon, a sequential storage device, or transferring an edited time base stream to a sequential storage device using an icon. Cited section, col. 7, lines 9-67, describes an editing system for manipulating media objects and composition media objects. Composition media objects are descriptions of constituent media objects. Media objects are object-oriented representations of source material. See Valdez, col. 7, lines 56-67. Applicant has been unable to discern any part of the cited section of Valdez, col. 7, lines 9-67, that teaches or suggests a sequential storage device and icon for transferring an edited time based stream to a sequential storage device. If the Examiner maintains the rejection of claims 1, 10, 24 and 31 based on these sections of Valdez, Applicant respectfully requests that the Examiner provide an explanation of how the cited sections support the rejection. Applicant also requests that the Examiner cite with greater specificity those sections of Valdez that Examiner argues teach each of these elements of claims 1, 10, 24 and 31,

because Applicant is unable to discern where in these cited sections the elements of claims 1, 10, 24 and 31 are taught.

Also, the Examiner admits on page 2 of Paper No. 13 that Valdez fails to explicitly teach "wherein said icon represents a function be performed on said sequential storage device." It appears contradictory to Applicant that the Examiner admits that Valdez fails to teach an icon to perform a function on a sequential storage device, yet at the same time maintains that Valdez teaches transferring a time based stream to a sequential storage device using an icon.

Further, the Examiner seeks to combine Dwyer with Valdez in order to teach these elements of claims 1, 10, 24 and 31. The Examiner cites the Abstract of Dwyer in col. 4, lines 50-67 to teach "wherein said icon represents a function to be performed on said sequential storage device." Dwyer relates to the movement and archiving of individual images. See Abstract, Dwyer. The Examiner's rejection based on a combination of Dwyer with Valdez fails to take or read the claim as a whole. Claims 1, 10, 24 and 31 claim an icon used to transfer an edited time based stream to a sequential storage device where the icon represents a function to be performed on the sequential storage device. Thus, the claims read as a whole indicate that the icon is used in connection with an edited time based stream. The Examiner has not indicated and Applicant has been unable to discern any part of Dwyer that teaches or suggests an icon representing a function where that icon can be used to transfer an edited time based stream to a sequential storage device. The manipulation of individual images as taught by Dwyer is well known to those skilled in the art to be a separate task from manipulation of a time based stream as claimed in claims 1, 10, 24 and 31. Thus, the Examiner has failed to establish that Dwyer teaches or suggests an icon to be used in connection with a time based stream. Rather, Dwyer is wholly concerned with the use of icons in the context of individual images.

Further, the Examiner has failed to properly establish a motivation for combining Dwyer with Valdez. The Examiner argues that one of ordinary skill in the art would see that the icon system of Dwyer would be obvious to combine with Valdez to "allow images to be accessed randomly, and video can be easily manipulated into any desired sequence where is in media clip

video editing system." However, Valdez presents a system for manipulating media objects which are to be associated with a video signal to provide interactive elements that are to be displayed concurrently with the video. These media objects are object oriented objects and the components thereof such as images are accessible through the object oriented interface. The image file manipulation system of Dwyer and the object oriented media objects of Valdez operate based on different paradigms and the Examiner has offered no argument based in the references to overcome this incompatibility. One of ordinary skill in the art would not think to combine the image archiving system of Dwyer which operates on simple files with the object oriented system of Valdez which operates on composition media objects and constituent media objects.

The combination of these two references requires a change in the fundamental operating principle of Valdez which operates in the object oriented paradigm to accommodate the flat file system paradigm of Dwyer. Thus, for the reasons set forth above, Dwyer cannot be combined with Valdez because it proposes a modification that would change the principle of operation of Valdez and thus the combination of these references is not sufficient to render the claims *prima facie* obvious. See *In Re Ratti*, 270, F.2d 810, 123, USPQ 349 (CCPA 1959) and MPEP § 2143.01. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 1, 10, 24 and 31 are requested.

In regard to claims 3-5, 12-14, 16-23, and 33-35, these claims depend from independent claims 1, 10, 24 and 31 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 1, 10, 24 and 31, these claims are not obvious over Valdez in view of Dwyer. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 3-5, 12-14, 16-23 and 33-35 are requested.

In regard to claims 2, 11, 25 and 32, these claims depend from independent claims 1, 10, 24 and 31 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 1, 10, 24 and 31, these claims are not obvious over Valdez in view of Dwyer. Further, the Examiner cites two full columns as well as figures 4-8 of Valdez as teaching these elements of claims 2, 11, 25 and 34 without providing any explanation as to how the cited sections

and figures of Valdez teach the elements of these claims. Applicant has reviewed the cited sections and figures and has been unable to discern any portion therein that teaches a three point editing between a source media and destination media. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 2, 11, 25 and 32. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested. In addition, the Examiner explicitly states that claim 25 contains allowable subject matter on page 4 of paper no. 13, thereby contradicting the rejection of claims 2, 11, 25 and 32.

In regard to claims 6 and 36, these claims depend from independent claims 1 and 31 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 1 and 31, these claims are not obvious over Valdez in view of Dwyer. Further, these claims include the elements of an icon that performs one of an insert edit, assembly edit and a preview edit. See, for example, claim 6, lines 3 and 4. The Examiner continues to cite col. 20, lines 1-64 as teaching these elements of claims 6 and 36. However, the Examiner has acknowledged that claims 26-28 which claim similar subject matter are not taught by Valdez. It is unclear to Applicant and Examiner has supplied no explanation as to how claims 26-28 are not taught by Valdez while claims 6 and 36 are taught by Valdez. Also, the Examiner provides no explanation as to what part of the cited section of Valdez teaches the elements of these claims. Applicant has been unable to discern any part of the cited section where these elements are set forth. Thus, the Examiner has failed to establish that Valdez in view of Dwyer teaches or suggests each of these elements of claims 6 and 36. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 6 and 36 are requested.

In regard to claim 7, 15, 29 and 37, the Examiner maintains the rejection of these claims and cites Figures 3A-4 of Valdez as teaching the elements of these claims. However, the Examiner has provided no explanation as to how Figures 3A-4 teach or suggest each of the elements of these claims. Applicant has reviewed these figures and has been unable to discern any part therein that teaches or suggests black and coding a tape. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 7, 15, 29 and 37. In addition, these claims depend

from independent claims 1, 10, 24 and 31 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 1, 10, 24 and 31, these claims are not taught or suggested by Valdez in view of Dwyer. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 7, 15, 29 and 37 are requested.

In regard to claims 8 and 38, these claims depend from independent claims 1 and 31, respectively and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to independent claims 1 and 31, these claims are not obvious over Valdez in view of Dwyer. Further, claims 8 and 38 include the elements of "using a timecode indicator" to "position a playhead of [a] sequential storage device." See, for example, claim 8, lines 2-3. The Examiner continues to cite col. 21, lines 1-67 of Valdez as teaching these elements of claims 8 and 38. The Examiner has not clearly identified and Applicant has been unable to discern any part of the cited section of Valdez that teaches positioning a playhead of a sequential device or positioning a playhead based on a timecode indicator. Applicant has been unable to discern any part of the cited section of Valdez that sets forth these elements of claims 8 and 38. Thus, the Examiner has failed to establish a *prima facie* case that Valdez in view of Dwyer does not teach or suggest each of the elements of claims 8 and 38. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 8 and 38 are requested.

In regard to claims 9 and 39, these claims depend from independent claims 1 and 31 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 1 and 31, these claims are not obvious over Valdez in view of Dwyer. Further, claims 9 and 39 include the elements of "using one of a mark in icon and a mark out icon to position a playhead of [a] sequential storage device." See, for example, claim 9, lines 2-3. The Examiner continues to cite col. 21, lines 1-67 of Valdez as teaching these elements of claims 9 and 39. The Examiner has not clearly identified and Applicant has been unable to discern any part of the cited section of Valdez that teaches positioning a playhead of the sequential device or positioning a playhead based on a timecode indicator, mark in icon or mark out icon. Thus, the Examiner has failed to establish that Valdez in view of Dwyer teaches or suggests each of the elements of the claims 9 and 39.

Accordingly, reconsideration and withdrawal of the obviousness rejections of claims 9 and 39 are requested.

II.   Subject Matter

Applicant notes with appreciation that the Examiner has indicated that claims 25-28 and 30 would be allowable if rewritten in independent form. For the reasons mentioned above, Applicant believes that claim 24 is now in condition for allowance and thus dependent claims 25-28 and 30 are in condition for allowance. Accordingly, reconsideration and withdrawal of the objection of claims 25-28 and 30 are requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-39 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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